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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,298	02/26/2004	Steven L. Purcell	RIC-03-003	1949
25537	7590	12/27/2004	EXAMINER	
MCI, INC TECHNOLOGY LAW DEPARTMENT 1133 19TH STREET NW, 10TH FLOOR WASHINGTON, DC 20036			MAYO, TARA L	
			ART UNIT	PAPER NUMBER
			3671	

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/786,298	Applicant(s) PURCELL, STEVEN L.	
	Examiner Tara L. Mayo	Art Unit 3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-13,23-26,28,29,31 and 32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4,6,7,11-13,23,24,28,29,31 and 32 is/are rejected.
7) ☒ Claim(s) 8-10,25 and 26 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The prior objection to the Specification has been overcome by the response filed 21 October 2004.

Claim Objections

2. The prior objections to claims 6, 18 and 28 for minor informalities have been overcome by the response filed 21 October 2004.
3. Claim 31 is objected to because of the following informalities: dependency upon a canceled claim. In claim 31 on line 1, change the dependency of the claim from claim 30. For the purposes of prosecution on the merits the Examiner has considered the claim to be dependent upon claim 23. Appropriate correction is required.
4. Claim 32 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 112

5. The prior rejection of claims 5, 17 and 27 under 35 USC 0167 112, second paragraph have been overcome by the response filed 21 October 2004.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 through 4, 7, 11, 12, 23, 29 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Finzel et al. (U.S. Patent No. 6,371,691 B1).

Finzel et al. '691, as seen in Figures 54 and 55, disclose a method of placing cable beneath a roadway comprising the steps of:

with regard to claims 1 and 23,

the steps of cutting a trench (VN) into the surface of the roadway;

placing a duct (VP) in the trench;

filling the trench with a sealer (B);

placing a first cable (MK) with the duct;

pulling the first cable out of, and through the duct; and

placing a second cable (MK) within the duct without removing the sealer within the trench (col. 26, lines 4 through 21);

with regard to claim 2,

wherein the first cable comprises utility cable;

with regard to claims 3 and 24,

wherein the first cable comprises optical fiber cable;

with regard to claims 4 and 23,

wherein the trench is cut to a depth of approximately 3.5 to 4.0 inches beneath the surface of the roadway (col. 3, lines 1 through 6);

with regard to claim 7,

wherein the trench is cut to a width of approximately 0.5 inches (col. 3, lines 1 through 6);

with regard to claim 11,

further comprising placing sand (20) within the trench;

with regard to claim 12,

wherein the sealer comprises bitumen (col. 23, lines 54 through 58);

with regard to claim 23,

the duct including a tubular material having a hollow inner diameter within the trench;
and

with regard to claim 29,

wherein the tubular material comprises an outer diameter of approximately 0.5 inch and an inner diameter of approximately 0.375 inch (col. 2, lines 42 through 56).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6, 13, 28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finzel et al. (U.S. Patent No. 6,371,691 B1).

Finzel et al. '691 disclose all of the limitations of the claimed method with the exception(s) of:

with regard to claims 6 and 28,

the duct comprising high density polyethylene (HDPE); and

with regard to claims 13 and 31,

the sealer being heated to between approximately 325 and 375 degrees Fahrenheit before filling the trench.

With regard to claims 6 and 28, Finzel et al. '691 teach a polyethylene duct (col. 22, lines 10 through 14) but fail to expressly teach high-density polyethylene (HDPE). However, it is a well-known expedient in the art of conduits to use HDPE for ducts surrounding cables in subsurface applications because it possesses good impact strength and chemical resistance.

With regard to claims 13 and 31, while Finzel et al. '691 do not expressly teach the claimed temperature range, the limitation is anticipated by the reference because it is inherent to roadway applications requiring the use of hot melt bitumen.

Allowable Subject Matter

10. Claims 8 through 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

12. Applicant's arguments with respect to claims 1 and 23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to

Art Unit: 3671

37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tara L. Mayo whose telephone number is 703-305-3019. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will can be reached on 703-308-3870. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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21 December 2004



Thomas B. Will
Supervisory Patent Examiner
Group 3600